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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,398	02/17/2004	Valiuddin Ali	200314072-1	1614

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INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

WILLIAMS, JEFFERY L

ART UNIT	PAPER NUMBER
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2137

NOTIFICATION DATE	DELIVERY MODE
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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/780,398	Applicant(s) ALI ET AL.	
	Examiner JEFFERY WILLIAMS	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/2/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1 – 46 are pending.

This action is in response to the communication filed on 12/13/07.

All objections and rejections not set forth below have been withdrawn.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14 – 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, these claims broadly recite computer elements as software per se (see par. 12, 16 of applicant's specification, wherein the recited means are disclosed as software [e.g. "software", "software driver", "application"]). Computer instructions without a tangible and statutory embodiment fail to fall within one of the statutory categories of invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Thompson et al. (Thompson), “Device Security Mechanism Based on Registered Passwords”, EP 1,111,495 A1.

Regarding claim 1, Thompson discloses:

a processor; and a memory component that stores (fig. 2:100):

a security module adapted to control access to a secure computer resource by a user via a client based on verification of a security credential provided by the user (fig. 2:108; par. 11);

and verification data disposed on the client and accessible by the security module (fig. 4:404, 406, 408, 412, 414, 416, 418 – herein disclosed is information disposed on the client which implements a recovery mechanism), the security module adapted to enable the user to recover the security credential from the client based on a response received from the user associated with the verification data (fig. 6). For the purpose of examination, the examiner interprets “to recover the security credential from the client” in a manner consistent with the applicant’s specification. Specifically, the applicant states in paragraph 15, “For example, as used herein, “recovering” security credential 100 includes enabling the user to independently retrieve security credential 100, enabling the user to independently reset security credential 100, and/or automatically having security credential 100 reset for the user by security module 70 without assistance from support personnel or an external computer resource.”

Regarding claim 2, Thompson discloses:

wherein the security module is adapted to enable the user to reset the security credential based on the response (fig. 4:414).

Regarding claim 3, Thompson discloses:

wherein the security module is adapted to generate a query to present to the user based on the verification data (fig. 6:602,608,610).

Regarding claim 4, Thompson discloses:

wherein the security module is adapted to control booting of the client based on the response (Abstract).

Regarding claim 5, Thompson discloses:

wherein the security module is adapted to initiate a collection module to acquire the verification data from the user (fig. 4).

Regarding claim 6, Thompson discloses:

wherein the security module is adapted to encrypt the security credential based on the verification data (fig. 4:406).

Regarding claim 7, Thompson discloses:

wherein the security module is adapted to decrypt an encrypted security credential based on the response (par. 22).

Regarding claim 8, Thompson discloses:

wherein the security module is disposed in a basic input/output system (BIOS)
(par. 11).

Regarding claim 9, Thompson discloses:

wherein the security module is adapted to control access to a secure communications network (col. 6:40-44 – access to the operations of the client [i.e. network access], is controlled).

Regarding claim 10, Thompson discloses:

wherein the security module is adapted to control access to a computer network resource (col. 6:40-44 – access to the operations of the client [i.e. network resource access] is controlled).

Regarding claim 11, Thompson discloses:

wherein the security module is adapted to enable the user to retrieve the security credential based on the response (par. 22).

Regarding claim 12, Thompson discloses:

wherein the security module is adapted to automatically reset the security credential based on the response (fig. 6:610,612,614,616,618).

Regarding claim 13, Thompson discloses:

wherein the security module is disposed on the client (fig. 2).

Regarding claims 14 – 46, they are system method and means claims essentially corresponding to claims 1 – 13, and they are rejected, at least, for the same reasons.

Response to Arguments

Applicant's arguments filed 6/2/08 have been fully considered but they are not persuasive.

Applicant argues essentially that:

(i) *With regard to claims 14 - 18, Applicants respectfully traverse this rejection for at least the reason that these claims include "means for" language that invokes 35 U.S.C. §112 116. As "means for" claims are a statutorily recognized claim, Applicants submit that these claims, in their current format, meet all the requirements of 35 U.S.C. §101. As additional proof, MPEP §2181 states (quoting In re Donaldson Co., 16 F.3d 1189,*

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1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994)(in banc))"35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language "shall be construed to cover the corresponding structure" (emphasis added). Accordingly, Applicants submit that this rejection is improper and that claims 14- 18 meet all the requirements of 35 U.S.C. §101. (Remarks, pg. 10)

In response, the examiner respectfully points out that the recitation of "means for" does not necessarily result in a "statutorily recognized claim". In the present case, the applicant has shown within the applicant's specification that the recited means of claims 14 – 18 are implemented as software (e.g. see par. 12, 16). Because these claims recite software per se. they are appropriately rejected as non-statutory.

(ii) *There is absolutely no suggestion of recovering the password. For at least the reason that Thompson fails to even suggest this element of claim 1, claim 1 is allowable.*

There is absolutely no suggestion of recovering the password. For at least the reason that Thompson fails to even suggest this element of claim 14, claim 14 is allowable.

There is absolutely no suggestion of recovering the password. For at least the reason that Thompson fails to even suggest this element of claim 19, claim 19 is allowable.

There is absolutely no suggestion of recovering the password. For at least the reason that Thompson fails to even suggest this element of claim 31, claim 31 is allowable.

There is absolutely no suggestion of recovering the password. For at least the reason that Thompson fails to even suggest this element of claim 40, claim 40 is allowable. (Remarks, pg. 11 – 18)

In response, the examiner respectfully reminds the applicant of the applicant's own disclosure, wherein the applicant states that *"recovering the password"* comprises *"enabling the user to independently retrieve security credential 100, enabling the user to independently reset security credential 100, and/or automatically having security credential 100 reset for the user by security module 70 without assistance from support*

personnel or an external computer resource.” As the recovery mechanism of the prior art is consistent with this interpretation, the examiner kindly notes that the prior art discloses the claimed features (e.g. Thompson, fig. 4).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

See Notice of References Cited.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFERY WILLIAMS whose telephone number is (571)272-7965. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Williams
AU: 2137

/Nasser G Moazzami/
Supervisory Patent Examiner, Art Unit 2136